

ESTTA Tracking number: **ESTTA1153215**

Filing date: **08/13/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	University of Kentucky
Granted to Date of previous extension	08/15/2021
Address	JOE CRAFT CENTER, 338 LEXINGTON AVENUE LEXINGTON, KY 40506 UNITED STATES
Attorney information	ANTHONY F. BONNER DINSMORE & SHOHL LLP CITY CENTER, 100 E. MAIN STREET SUITE 900 LEXINGTON, KY 40507 UNITED STATES Primary Email: trademarks@dinsmore.com Secondary Email(s): tony.bonner@dinsmore.com, tamara.head@dinsmore.com, Stephanie.Crigler@DINSMORE.COM, Hilary.Crookston@DINSMORE.COM, shelly.burchfield@dinsmore.com 859-425-1024
Docket Number	129529-21

### Applicant Information

Application No.	88848403	Publication date	02/16/2021
Opposition Filing Date	08/13/2021	Opposition Period Ends	08/15/2021
Applicant	Commonwealth of Kentucky 500 MERO STREET, 5TH FLOOR FRANKFORT, KY 40601 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. First Use: 2020/03/26 First Use In Commerce: 2020/03/26

All goods and services in the class are opposed, namely: Clothing, namely, t-shirts, sweatshirts, polo shirts, dress shirts, jackets, sweaters, golf shirts, cardigans, pants, shorts, sweat pants, socks, hats, caps being headwear

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)

False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Deceptiveness	Trademark Act Section 2(a)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2066804	Application Date	04/05/1996
Registration Date	06/03/1997	Foreign Priority Date	NONE
Word Mark	KENTUCKY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 1940/12/31 First Use In Commerce: 1940/12/31 magazines regarding college athletics and alumni news, athletic exhibition schedules, trading cards, art prints, posters, decals, bumper stickers, [ books regarding history, ] ink pens, and stationery</p> <p>Class 025. First use: First Use: 1940/12/31 First Use In Commerce: 1940/12/31 swim suits, hats, sweaters, children's football/baseball jerseys, sweatshirts, T-shirts, shoes, shorts, jackets, athletic jerseys, and aprons</p>		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	KENTUCKY		
Goods/Services	athletic team uniforms, swim suits, hats, sweaters, children's football/baseball jerseys, sweatshirts, T-shirts, shoes, shorts, jackets, athletic jerseys, and apron		

Attachments	2021-08-13 Final Notice of Opposition.pdf(298414 bytes )
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Signature	/afb/
Name	Anthony F. Bonner
Date	08/13/2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration Application Serial No. 88/848,403

Filed March 26, 2020

For the mark TEAM KENTUCKY & Design  
Published in the *Official Gazette* on February 16, 2021

UNIVERSITY OF KENTUCKY,	:	
	:	
Opposer,	:	
v.	:	OPPOSITION NO. _____
	:	
COMMONWEALTH OF KENTUCKY,	:	
	:	
Applicant.	:	

**NOTICE OF OPPOSITION**

The University of Kentucky (“Opposer”), an agency and instrumentality of the Commonwealth of Kentucky, having a place of business at 338 Lexington Avenue, Joe Craft Center, Lexington, Kentucky, 40506-0604, believes it will be damaged by registration of the mark TEAM KENTUCKY & Design in Application Serial No. 88/848,403 in Class 25, and hereby opposes the same. The fee under 37 CFR §2.6(a)(17)(\$600/class x 1) is being paid by Deposit Account at the time of filing with ESTTA.

As grounds for opposition, it is alleged that:

1. Opposer is a Kentucky state university having a place of business at 338 Lexington Avenue, Joe Craft Center, Lexington, Kentucky, 40506-0604.
2. Opposer uses a variety of marks in association with its educational, hospital, research and related services and uses and licenses same to identify apparel and collateral

merchandise associated with Opposer and its athletic teams, athletic team uniforms, and a broad range of apparel, footwear, and accessories.

3. Since at least as early as December 31, 1940, Opposer has used the word mark KENTUCKY to identify clothing, including but not limited to athletic team uniforms, athletic jerseys, T-shirts, shorts, sweatshirts, and hats.

4. On June 3, 1997, the U.S. Patent and Trademark Office issued U.S. Registration No. 2,066,804 (the “‘804 Registration”) for the mark KENTUCKY to identify inter alia “athletic jerseys, hats, T-shirts, sweatshirts, and jackets” in International Class 25. *See Exhibit A.*

5. The ‘804 Registration issued well prior to Applicant’s March 26, 2020 filing date.

6. Opposer is the owner of the ‘804 Registration.

7. Opposer has continuously used the KENTUCKY mark in interstate commerce to identify its clothing, including athletic team uniforms, athletic jerseys, T-shirts, shorts, sweatshirts, and hats since at least as early as 1997 and continues to use the mark.

8. The ‘804 Registration is now incontestable pursuant to 15 U.S.C. § 1065, providing conclusive evidence of Opposer’s ownership of the mark and of its exclusive right to use the registered mark in commerce.

9. On information and belief, Applicant is the identified owner of Application Serial No. 88/848,403 (the “‘403 Application”) for the mark TEAM KENTUCKY & Design.

10. The ‘403 Application alleges a date of first use in commerce of March 26, 2020, for “clothing, namely, t-shirts, sweatshirts, polo shirts, dress shirts, jackets, sweaters, golf shirts, cardigans, pants, shorts, sweat pants, socks, hats, caps being headwear” in Class 25.

11. The class 25 identification of goods in the ‘403 Application does not include any conditions or limitations on use.

12. Applicant had constructive notice of Opposer’s ownership of federally registered rights to the KENTUCKY mark under 15. U.S.C. § 1072 since at least as early as 1997.

### **COUNT I**

#### **LIKELIHOOD OF CONFUSION**

13. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 12.

14. Applicant’s TEAM KENTUCKY & Design mark so resembles the Opposer’s KENTUCKY mark as to be likely, when used on or in connection with Applicant’s goods identified in the ‘403 Application, to cause confusion, to cause mistake, and/or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052 (d).

15. The goods identified in the ‘403 Application are identical or highly similar to those on which Opposer uses its KENTUCKY mark.

16. The goods identified in the ‘403 Application are presumed to be sold and distributed through the same, similar, and/or overlapping channels of commerce with Opposer’s identical or highly similar goods.

17. Applicant knew or should have known of Opposer’s KENTUCKY mark when Applicant applied to register the TEAM KENTUCKY & Design mark as identified in the ‘403 Application.

18. Applicant’s adoption of the TEAM KENTUCKY & Design mark as identified in the ‘403 Application is without the license or permission of Opposer.

19. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's TEAM KENTUCKY & Design mark and registration should be refused.

## **COUNT II**

### **NON-USE ON EACH OF THE GOODS LISTED IN THE APPLICATION**

20. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 19.

21. On information and belief, Applicant did not use the mark in commerce to identify each of the goods identified in Class 25 of the '403 Application as of the filing date of the application as required by Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

22. Registration should be denied for all the goods identified in the '403 Application on which Applicant failed to use the mark in commerce as of the date of filing the use-based '403 Application.

23. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's TEAM KENTUCKY & Design mark and registration should be refused

## **COUNT III**

### **DECEPTION AND FALSE SUGGESTION OF CONNECTION**

24. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 23.

25. Applicant's TEAM KENTUCKY & Design mark is highly similar to Opposer's KENTUCKY mark such that it is likely to cause deception in violation of Section 2(a) of the Trademark Act and materially alter purchasers' decisions to acquire Applicant's goods.

26. Applicant's TEAM KENTUCKY & Design mark is deceptive in that it falsely suggests a connection with or approval by Opposer.

27. Opposer is widely known within the parties' fields of operations, including in the field of apparel and merchandise.

28. Due to the emphasis of the word "KENTUCKY" in Applicant's mark, Applicant's mark falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act because Opposer's KENTUCKY mark points uniquely to Opposer and purchasers will assume that goods offered under Applicant's mark is connected with Opposer, which they are not.

29. When Applicant's mark is used in connection with the goods of the type described in the '403 Application, Applicant's use and registration of the opposed mark will cause purchasers to mistakenly assume Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's goods by permitting Applicant to use the TEAM KENTUCKY & Design mark on such goods.

30. Opposer's reputation is such that when Applicant's mark is used in connection with the applied-for goods, a connection with Opposer would be presumed.

31. Therefore, registration of Applicant's mark will damage Opposer within the meaning of 15 U.S.C. § 1052(a).

**CLAIM FOR RELIEF/DAMAGE**

32. By reason of the foregoing, Applicant's registration of the TEAM KENTUCKY & Design mark in Class 25 will cause injury and damage to Opposer as described above.

WHEREFORE, Opposer respectfully prays the present opposition be sustained, and the registration sought by the Applicant be refused.

Respectfully submitted,

Dated: August 13, 2021

DINSMORE & SHOHL LLP

By: /Anthony F. Bonner/

Anthony F. Bonner

Tamara A. Head

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*Attorneys for Opposer*



## **EXHIBIT A**

### **Notice of Opposition U.S. Reg. App. Ser. No. 88/697,729**

Copy of Certificate of Registration No. 2,066,804 for the mark KENTUCKY and a Current Copy of Information from TESS Showing the Current Status and Title Thereof per 37 CFR 2.122(d)(1)

**Generated on:** This page was generated by TSDR on 2021-08-13 10:32:47 EDT

**Mark:** KENTUCKY

**US Serial Number:** 75084190

**Application Filing Date:** Apr. 05, 1996

**US Registration Number:** 2066804

**Registration Date:** Jun. 03, 1997

**Register:** Principal

**Mark Type:** Trademark

**TM5 Common Status Descriptor:**



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

**Status:** The registration has been renewed.

**Status Date:** Dec. 22, 2017

**Publication Date:** Mar. 11, 1997

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## Mark Information

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**Mark Literal Elements:** KENTUCKY

**Standard Character Claim:** No

**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

**Acquired Distinctiveness Claim:** In whole

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## Related Properties Information

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**Claimed Ownership of US Registrations:** 1607719, 1618023

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## Goods and Services

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**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** magazines regarding college athletics and alumni news, athletic exhibition schedules, trading cards, art prints, posters, decals, bumper stickers, [ books regarding history, ] ink pens, and stationery

**International Class(es):** 016 - Primary Class

**U.S Class(es):** 002, 005, 022, 023, 029, 037, 038, 050

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Dec. 31, 1940

**Use in Commerce:** Dec. 31, 1940

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**For:** swim suits, hats, sweaters, children's football/baseball jerseys, sweatshirts, T-shirts, shoes, shorts, jackets, athletic jerseys, and aprons

**International Class(es):** 025 - Primary Class

**U.S Class(es):** 022, 039

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Dec. 31, 1940

**Use in Commerce:** Dec. 31, 1940

## Basis Information (Case Level)

**Filed Use:** Yes

**Currently Use:** Yes

**Filed ITU:** No

**Currently ITU:** No

**Filed 44D:** No

**Currently 44E:** No

**Filed 44E:** No

**Currently 66A:** No

**Filed 66A:** No

**Currently No Basis:** No

**Filed No Basis:** No

## Current Owner(s) Information

**Owner Name:** UNIVERSITY OF KENTUCKY

**Owner Address:** Joe Craft Center, 338 Lexington Avenue  
Lexington, KENTUCKY UNITED STATES 405060604

**Legal Entity Type:** STATE UNIVERSITY

**State or Country Where Organized:** KENTUCKY

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Michael S. Hargis

**Docket Number:** 850-012 AT

**Attorney Primary Email Address:** [michael@iplaw1.net](mailto:michael@iplaw1.net)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Michael S. Hargis  
KING & SCHICKLI, PLLC  
800 Corporate Drive, Suite 200  
LEXINGTON, KENTUCKY UNITED STATES 40503

**Phone:** 8592520889

**Fax:** 8592520779

**Correspondent e-mail:** [michael@iplaw1.net](mailto:michael@iplaw1.net) [uspto@iplaw1.net](mailto:uspto@iplaw1.net)

**Correspondent e-mail Authorized:** Yes

**Domestic Representative - Not Found**

## Prosecution History

Date	Description	Proceeding Number
Dec. 22, 2017	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Dec. 22, 2017	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	75461
Dec. 22, 2017	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	75461
Dec. 22, 2017	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75461
Nov. 28, 2017	TEAS SECTION 8 & 9 RECEIVED	
Sep. 19, 2016	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 03, 2016	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Nov. 26, 2014	COUNTERCLAIM OPP. NO. 999999	214525
Sep. 23, 2008	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Sep. 23, 2008	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Dec. 05, 2006	CASE FILE IN TICRS	
Oct. 14, 2006	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	59136
Oct. 14, 2006	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Oct. 14, 2006	ASSIGNED TO PARALEGAL	59136

Aug. 10, 2006	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED
Aug. 10, 2006	TEAS SECTION 8 & 9 RECEIVED
Feb. 23, 2006	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED
Feb. 23, 2006	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED
Aug. 19, 2005	TEAS CHANGE OF OWNER ADDRESS RECEIVED
Aug. 19, 2005	TEAS CHANGE OF CORRESPONDENCE RECEIVED
Jul. 16, 2003	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.
Apr. 14, 2003	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED
Apr. 07, 2003	PAPER RECEIVED
Apr. 14, 2003	TEAS SECTION 8 & 15 RECEIVED
Jun. 03, 1997	REGISTERED-PRINCIPAL REGISTER
Mar. 11, 1997	PUBLISHED FOR OPPOSITION
Feb. 07, 1997	NOTICE OF PUBLICATION
Nov. 02, 1996	APPROVED FOR PUB - PRINCIPAL REGISTER
Oct. 18, 1996	CORRESPONDENCE RECEIVED IN LAW OFFICE
Aug. 19, 1996	NON-FINAL ACTION MAILED
Aug. 14, 1996	ASSIGNED TO EXAMINER

69222

## TM Staff and Location Information

### TM Staff Information - None

#### File Location

**Current Location:** GENERIC WEB UPDATE

**Date in Location:** Dec. 22, 2017

**Int. Cls.: 16 and 25**

**Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 39 and 50**

**Reg. No. 2,066,804**

**United States Patent and Trademark Office**

**Registered June 3, 1997**

**TRADEMARK  
PRINCIPAL REGISTER**

**KENTUCKY**

UNIVERSITY OF KENTUCKY (KENTUCKY  
STATE UNIVERSITY)  
LEXINGTON, KY 405060019

FOR: MAGAZINES REGARDING COLLEGE  
ATHLETICS AND ALUMNI NEWS, ATHLETIC  
EXHIBITION SCHEDULES, TRADING CARDS,  
ART PRINTS, POSTERS, DECALS, BUMPER  
STICKERS, BOOKS REGARDING HISTORY,  
INK PENS, AND STATIONERY, IN CLASS 16  
(U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 12-31-1940; IN COMMERCE  
12-31-1940.

FOR: SWIM SUITS, HATS, SWEATERS,  
CHILDREN'S FOOTBALL/BASEBALL JER-

SEYS, SWEATSHIRTS, T-SHIRTS, SHOES,  
SHORTS, JACKETS, ATHLETIC JERSEYS,  
AND APRONS, IN CLASS 25 (U.S. CLS. 22 AND  
39).

FIRST USE 12-31-1940; IN COMMERCE  
12-31-1940.

OWNER OF U.S. REG. NOS. 1,607,719 AND  
1,618,023.

SEC. 2(F).

SER. NO. 75-084,190, FILED 4-5-1996.

NORA BUCHANAN WILL, EXAMINING AT-  
TORNEY